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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/578,415

Applicant(s)

BUSEY, ANDREW THOMAS

Examiner

BLAKE RUBIN

Art Unit

2457

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to a request for continued examination filed November 14, 2008.
2. This application claims priority, under 35 U.S.C. 371, to PCT/US05/13068, which claims priority to provisional applications 60/563,705, 60/563,706, 60/563,719, 60/563,713, and 60/563,615, all of which were filed on April 20, 2004.
3. Claims 1-7, 9-15, 17-23 are pending in this application. Claims 1, 9, and 17 are currently amended. Claims 8, 16, and 24 been currently cancelled.

Claim Objections

4. Claims 1, 9, and 17 objected to because of the following informalities: the claim recites, "saved in second personal folder" (claim 1 - line 12, claim 9 – line 14, and claim 17 – line 16) which renders the wording of the claim awkward, the examiner suggest amending the claim to recite, "saved in a second personal folder". Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-7, and 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

7. With respect to claim 1, a method is recited. However, to be considered statutory subject matter, a method must either (1) be tied to another statutory class by specific recitation of the other statutory class, or (2) transform the underlying subject matter to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

8. With respect to the first prong, these methods do not meet the requirements set forth because the recitation of a general purpose computer is not a particular apparatus within the meaning of the test. With respect to the second prong, the underlying subject matter is not transformed to a different state or thing, because it is merely electrical signals.

9. With respect to claims 2-7, the claims fail to resolve the deficiencies of independent claim on which they are based, and are therefor rejected on the same grounds as above.

10. With respect to claim 9, a system is recited. However, the system lacks a physical embodiment on which it is to be carried out, and therefor is directed toward non-statutory subject matter as software per se. Without a physical embodiment, the receiving, translating, saving, and synchronizing can all be realized strictly through the processing of software.

11. With respect to claims 10-15, the claims fail to resolve the deficiencies of independent claim on which they are based, and are therefor rejected on the same grounds as above.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-7, 9-15, and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhang (US Patent No. 6,865,599, hereinafter Zhang) in view of Wong et al (U.S. Patent No. 6,708,172, hereinafter Wong), in view of O'Brien et al (U.S. Patent Application Publication No. 2002/0133561, hereinafter O'Brien).

14. With respect to claim 1, Zhang discloses a computer implemented method (column 4, lines 1-2), comprising:

Receiving, by at least one first information handling system, comprising a computing device, of a user, an excerpt of information associated with the user (column 9, lines 3-4);

in response to receiving the excerpt, automatically translating the excerpt into an XML format (column 9, lines 5-6), to be compatible for operation (column 9, lines 13-15)

with at least one second information handling system of the user (column 9, lines 10-12);

the translated excerpt including a user-specified item of music (column 14, lines 41-44); and

synchronizing the translated excerpt with the second information handling system (column 9, lines 10-12).

But does not disclose:

translating into a compatible XML format without further translation,
saving the translated excerpts in folders associated with the users, or
a third information handling system.

However, Wong discloses communicating with a third information handling system associated with a server (column 16, lines 36-38; column 18, lines 51-62).

It would have been obvious to one skilled in the art at the time the invention was made to combine the cross platform exchange of Zhang with the server synchronization of Wong because a neutral party provides additional security and authentication by validating all end users of the system (Wong, column 18, lines 51-54).

However, O'Brien discloses translating into a compatible XML format without further translation (paragraph [0092], lines 8-11).

saving the translated excerpt (paragraph [0133], lines 1-3) in a first personal folder associated with a user of the first information handling system (paragraph [0144]; Figure 13, X:\ **1322**),

a version of the translated excerpt saved (paragraph [0133], lines 1-3) in second personal folder associated with the user of the second information handling system (paragraph [0143]; Figure 13, My Computer Window **1310**).

It would have been obvious to one skilled in the art at the time the invention was made to combine Zhang and Wong with the internet storage drive and directory hierarchy of O'Brien because reducing the amount of translations increases the processing efficiency of the method.

15. With respect to claim 2, the combination of Zhang, Wong, and O'Brien discloses the method of claim 1, Zhang further discloses the excerpt has a non-XML format (column 8, lines 22-24), and wherein automatically translating (column 8, lines 24-26) comprises:

in response to the excerpt, automatically translating the excerpt from the non-XML format into the XML format (column 8, lines 24-26), to be compatible for operation with the second information handling system (column 9, lines 13-15).

16. With respect to claim 3, the combination of Zhang, Wong, and O'Brien discloses the method of claim 1, Zhang further discloses the excerpt has an alternate XML format (column 8, lines 28-30), and wherein automatically translating (column 8, lines 52-54) comprises:

in response to the excerpt, automatically translating the excerpt from the alternate XML format into a generic XML format (column 8, lines 28-30, and 52-54;

whereby the XPointer, the alternate XML format, is translated to a generic XML format, similarly to the DOM Event Model for cross platform exchange), to be compatible for operation with the second information handling system (column 9, lines 13-15).

17. With respect to claim 4, the combination of Zhang, Wong, and O'Brien discloses the method of claim 1, Zhang further discloses saving the XML-formatted excerpt (column 7, lines 36-37) in a personal folder of the user (column 31, lines 18-21).

18. With respect to claim 5, the combination of Zhang, Wong, and O'Brien discloses the method of claim 1, Zhang further discloses the XML-formatted excerpt (column 7, lines 36-37) is a user-specified website (column 6, lines 27-29).

19. With respect to claim 6, the combination of Zhang, Wong, and O'Brien discloses the method of claim 1, Zhang further discloses the XML-formatted excerpt (column 7, lines 36-37) is a user-specified search query (Figure 26).

20. With respect to claim 7, the combination of Zhang, Wong, and O'Brien discloses the method of claim 1, Zhang further discloses the XML-formatted information (column 7, lines 36-37) is a user-specified search result (Figure 26).

21. With respect to claim 9, Zhang discloses a system, comprising:

at least one first information handling system, comprising a computing device, of a user (column 4, lines 1-2) for:

receiving an excerpt of information associated with the user (column 9, lines 3-4);
in response to receiving the excerpt, automatically translating the excerpt into an XML format (column 9, lines 5-6), to be compatible for operation (column 9, lines 13-15) with at least one second information handling system of the user (column 9, lines 10-12);

the translated excerpt including a user-specified item of music (column 5, lines 13-17); and

synchronizing the translated excerpt with the second information handling system (column 9, lines 10-12).

But does not disclose:

translating into a compatible XML format without further translation,
saving the translated excerpts in folders associated with the users, or
a third information handling system.

However, Wong discloses communicating with a third information handling system associated with a server (column 16, lines 36-38; column 18, lines 51-62).

It would have been obvious to one skilled in the art at the time the invention was made to combine the cross platform exchange of Zhang with the server synchronization of Wong because a neutral party provides additional security and authentication by validating all end users of the system (Wong, column 18, lines 51-54).

However, O'Brien discloses translating into a compatible XML format without further translation (paragraph [0092], lines 8-11).

saving the translated excerpt (paragraph [0133], lines 1-3) in a first personal folder associated with a user of the first information handling system (paragraph [0144]; Figure 13, X:\ **1322**),

a version of the translated excerpt saved (paragraph [0133], lines 1-3) in second personal folder associated with the user of the second information handling system (paragraph [0143]; Figure 13, My Computer Window **1310**).

It would have been obvious to one skilled in the art at the time the invention was made to combine Zhang and Wong with the internet storage drive and directory hierarchy of O'Brien because reducing the amount of translations increases the processing efficiency of the method.

22. With respect to claim 10, the combination of Zhang, Wong, and O'Brien discloses the system of claim 9, Zhang further discloses the excerpt has a non-XML format (column 8, lines 22-24), and wherein the first information handling system is for:

in response to receiving the excerpt, automatically translating (column 8, lines 24-26) the excerpt from the non-XML format into the XML format (column 8, lines 24-26), to be compatible for operation with the second information handling system (column 9, lines 13-15).

23. With respect to claim 11, the combination of Zhang, Wong, and O'Brien discloses the system of claim 9, Zhang further discloses the excerpt has an alternate XML format (column 8, lines 28-30), and wherein the first information handling system is for:

in response to receiving the excerpt, automatically translating (column 8, lines 52-54) the excerpt from the alternate XML format into a generic XML format (column 8, lines 28-30, and 52-54; *whereby the XPointer, the alternate XML format, is translated to a generic XML format, similarly to the DOM Event Model for cross platform exchange*), to be compatible for operation with the second information handling system (column 9, lines 13-15).

24. With respect to claim 12, the combination of Zhang, Wong, and O'Brien discloses the system of claim 9, and Zhang further discloses the first information handling system is for: saving the XML-formatted excerpt (column 7, lines 36-37) in a personal folder of the user (column 31, lines 18-21).

25. With respect to claim 13, the combination of Zhang, Wong, and O'Brien discloses the system of claim 9, Zhang further discloses the XML-formatted excerpt (column 7, lines 36-37) is a user-specified website (column 6, lines 27-29).

26. With respect to claim 14, the combination of Zhang, Wong, and O'Brien discloses the system of claim 9, Zhang further discloses the XML-formatted excerpt (column 7, lines 36-37) is a user-specified search query (Figure 26).

27. With respect to claim 15, the combination of Zhang, Wong, and O'Brien discloses the system of claim 9, Zhang further discloses the XML-formatted information (column 7, lines 36-37) is a user- specified search result (Figure 26).

28. With respect to claim 16, the combination of Zhang, Wong, and O'Brien discloses the system of claim 9, Zhang further discloses the XML-formatted information (column 7, lines 36-37) is a user- specified item of music (column 5, lines 13-17).

29. With respect to claim 17, Zhang discloses a computer program product stored on a computer readable medium (column 3, lines 26-29), comprising:

at least one computer program processable by at least one first information handling system, comprising a computing device, of a user (column 4, lines 1-2) for causing the first information handling system to:

receive an excerpt of information associated with the user (column 9, lines 3-4);
in response to receipt of the excerpt, automatically translate the excerpt into an XML format (column 9, lines 5-6), to be compatible, without further translation, for operation (column 9, lines 13-15) with at least one second information handling system of the user (column 9, lines 10-12);

the translated excerpt including a user-specified item of music (column 5, lines 13-17); and

synchronize the translated excerpt with the second information handling system (column 9, lines 10-12); and

apparatus from which the computer program is accessible by the first information handling system (column 4, lines 1-2).

But does not disclose:

translating into a compatible XML format without further translation,
saving the translated excerpts in folders associated with the users, or
a third information handling system.

However, Wong discloses communicating with a third information handling system associated with a server (column 16, lines 36-38; column 18, lines 51-62).

It would have been obvious to one skilled in the art at the time the invention was made to combine the cross platform exchange of Zhang with the server synchronization of Wong because a neutral party provides additional security and authentication by validating all end users of the system (Wong, column 18, lines 51-54).

However, O'Brien discloses translating into a compatible XML format without further translation (paragraph [0092], lines 8-11).

saving the translated excerpt (paragraph [0133], lines 1-3) in a first personal folder associated with a user of the first information handling system (paragraph [0144]; Figure 13, X:\ **1322**),

a version of the translated excerpt saved (paragraph [0133], lines 1-3) in second personal folder associated with the user of the second information handling system (paragraph [0143]; Figure 13, My Computer Window **1310**).

It would have been obvious to one skilled in the art at the time the invention was made to combine Zhang and Wong with the internet storage drive and directory hierarchy of O'Brien because reducing the amount of translations increases the processing efficiency of the method.

30. With respect to claim 18, the combination of Zhang, Wong, and O'Brien discloses the computer program product of claim 17, Zhang further discloses the excerpt has a non-XML format (column 8, lines 22-24), and wherein the computer program is processable by the first information handling system for causing the first information handling system to:

in response to receipt of the excerpt, automatically translate the excerpt (column 8, lines 24-26) from the non-XML format into the XML format (column 8, lines 24-26), to be compatible for operation with the second information handling system (column 9, lines 13-15).

31. With respect to claim 19, the combination of Zhang, Wong, and O'Brien discloses the computer program product of claim 17, Zhang further discloses the excerpt has an alternate XML format (column 8, lines 28-30), and wherein the computer program is processable by the first information handling system for causing the first information handling system to:

in response to receipt of the excerpt, automatically translate (column 8, lines 52-54) the excerpt from the alternate XML format into a generic XML format (column 8,

lines 28-30, and 52-54; *whereby the XPointer, the alternate XML format, is translated to a generic XML format, similarly to the DOM Event Model for cross platform exchange*), to be compatible for operation with the second information handling system (column 9, lines 13-15).

32. With respect to claim 20, the combination of Zhang, Wong, and O'Brien discloses the computer program product of claim 17, Zhang further discloses the computer program is processable by the first information handling system for causing the first information handling system to: save the XML-formatted excerpt (column 7, lines 36-37) in a personal folder of the user (column 31, lines 18-21).

33. With respect to claim 21, the combination of Zhang, Wong, and O'Brien discloses the computer program product of claim 17, Zhang further discloses the XML-formatted excerpt (column 7, lines 36-37) is a user-specified website (column 6, lines 27-29).

34. With respect to claim 22, the combination of Zhang, Wong, and O'Brien discloses the computer program product of claim 17, Zhang further discloses the XML-formatted excerpt (column 7, lines 36-37) is a user-specified search query (Figure 26).

35. With respect to claim 23, the combination of Zhang, Wong, and O'Brien discloses the computer program product of claim 17, Zhang further discloses the XML-formatted (column 7, lines 36-37) information is a user-specified search result (Figure 26).

36. With respect to claim 24, the combination of Zhang, Wong, and O'Brien discloses the computer program product of claim 17, Zhang further discloses the XML-formatted information (column 7, lines 36-37) is a user-specified item of music (column 5, lines 13-17).

Response to Arguments

37. Applicant's arguments with respect to claims 1-7, 9-15, and 17-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Logan et al U.S. Patent Application No. 2003/0093790

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLAKE RUBIN whose telephone number is (571) 270-3802. The examiner can normally be reached on M-R: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

12/30/08

/Rubin Blake/
Examiner, Art Unit 2457

/ARIO ETIENNE/
Supervisory Patent Examiner, Art Unit 2457